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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,473	12/31/2003	Rodney R. Wilkins	NFIBX 118	9873

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EXAMINER	
CECIL, TERRY K	
ART UNIT	**PAPER NUMBER**
1797	

NOTIFICATION DATE	DELIVERY MODE
01/15/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/750,473	WILKINS ET AL.	
	Examiner	Art Unit	
	Mr. Terry K. Cecil	1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 October 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-26* is/are pending in the application.

4a) Of the above claim(s) *26* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *one*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 2, 22 and 24-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Wnenchak. Wnenchak teaches a filter medium of polypropylene and modacrylic fibers (Technostat), wherein the fibers includes measurable amounts of extractable organic contaminants (lubricants, antistatic agents, etc) as in the table of col. 4, including amounts up to about 0.1%. The samples had a mass of 169.49 g/m2 (see col. 4, line 7) resulting in a weight percentage of approximately 0.1% (223.05/169490).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 2-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (U.S. 4,798,850). Brown teaches a filter material made of a blend of (i) polypropylene fibers and (ii) either modacrylic or acrylic fibers (col. 1, line 36 and line 53) and in the claimed ratios of the dependent claims (col. 1, lines 53-65). Brown desires his fibers to be "clean" but doesn't specify the value of residual contaminants after scouring of the fibers (he doesn't teach a measurable amount of at least one extractable agent to be less than about 0.1 weight percent). He does however indicate that the effectiveness in removing the contaminants is directly related to the thoroughness of the scouring (col. 2, lines 34-37) and that *if the resulting fibers are moderately clean then the filter will be moderately good* (col. 2, lines 37-38 and lines 49-50). The skilled man in the art would recognize that how well the filter performs is directly related to the amount of residual contaminants after scouring (that cleaner fibers result in a filter that performs better) and that the amount of residual contaminants is directly related to the thoroughness of fiber scouring as well as the thoroughness in cleaning the fiber processing machines (see col. 2, line 67- col. 3, line 6). *For better filter performance*, it would have been obvious to one ordinarily skilled in the art at the time the invention was made to minimize the amount of residual contaminates—to be e.g. less than 0.1 weight percent—by allocating more time, energy, and expense to the cleaning of the fibers and the fiber processing machines.

As for claim 23, Brown teaches that his polypropylene fibers can be made finish free (and not require scouring; see col. 2, lines 31-34). It is also pointed out that claim 23 is a product-by-process limitation. Applicant is reminded that "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695,698, 227 USPQ 964; 966 (Fed. Cir. 1985). As shown above, the process of Brown still results in a product filter media having measurable amounts of extractables.

Response to Arguments

5. Applicant's arguments filed 10-22-2007 have been fully considered but they are not persuasive.

- Applicant states that Brown says that his fibers are clean and that by "clean" he means that the fiber has no coating of lubricant or anti-static agent. However, it is pointed out that applicant's claimed "at least one extractable agent" is not limited to such agents. No special definition for the term (phrase) is found in the specification. Applicant is reminded that during prosecution claims must be given their broadest reasonable interpretation. The Examiner contends that "at least one extractable agent" is broad enough to read on dirt, dust, or any agent not explicitly cited in the claims. Nothing in Brown suggests that such sterile conditions are maintained at any time in his process. The skilled man would recognize that dirt, dust or some other contaminant would be found in the product that is "measurable" in a

minute concentration, e.g. less than about 0.1 weight percent. *Applicant may wish to limit his "at least one extractable agent" to those agents of his concern (e.g. those agents used in a process to make the fibers).*

- Concerning Wnenchak, the Examiner contends that since the references clearly states that the results are given terms of mg per m2 of 169.40 g per m2 of material, changing the 169.40 to 1694000 to have consistent units and finding the corresponding ratio of contaminant to this amount of material is proper for finding the percent of contaminants remaining.

Conclusion

6. In view of the Reply Brief filed on 10-22-2007, PROSECUTION IS HEREBY REOPENED. New Ground of Rejection were set forth above.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/David R. Sample/
David Sample
Supervisory Patent Examiner

7. Contact Information:

- Examiner Mr. Terry K. Cecil can be reached at (571) 272-1138 at the Carlisle campus in Alexandria, Virginia for any inquiries concerning this communication or earlier communications from the examiner. Note that the examiner is on the increased flextime

schedule but can normally be found in the office during the hours of 8:30a to 4:30p, on at least four days during the week M-F.

- David R. Sample, the examiner's supervisor can be reached on 571-272-1376, if attempts to reach the examiner are unsuccessful.
- The Fax number for this art unit for official faxes is (571) 273-8300.
- Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mr. Terry K. Cecil
Primary Examiner
Art Unit 179797

TKC
January 7, 2008